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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,216	05/18/1999	DAVID L. SILVERMAN	3432.80970	3594

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/313,216

Applicant(s)

SILVERMAN ET AL.

Examiner

Jan Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the applicant's communication filed on October 12, 2004, wherein:

Claims 12-36 are currently pending;

Claims 12-36 have been amended;

No claims have been added;

No claims have been cancelled.

#### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant states in the preamble that the invention is a first user terminal.

Applicant then goes on to state that the terminal performs the steps of... The applicant also states that the first terminal comprises a user interface display for negotiating trades between a first user and a second user. It is unclear how the interface display negotiates trades.

Furthermore, the applicant starts out claiming a first user terminal which is part of a negotiated matching system. The applicant then goes on to identify the negotiated matching system but not provides no structure as to the first user terminal.

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3. The applicant is also claiming an apparatus and then the method steps for using the apparatus (Claims 12-28).

MPEP 2173.05(p) states:

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission work stand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

The applicant may want to consider using means plus function language.

4. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant states that the invention is a method for negotiating a potential transaction. However, the applicant never claims any negotiating steps.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 12-28 are rejected under 35 U.S.C. 101 under MPEP section 2173.05(p) which states:

Such claims should also be rejected under 35 U.S.C.101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverman et al (US 5,136, 501 or 5, 077,665) (hereinafter referred to as Silverman).

Silverman discloses a negotiated matching system and a method for displaying a user interface on at least one terminal in a negotiated matching system comprising six display regions (Figs. 1-20, Figs. 4-5, 13-18 have multiple display regions).

Silverman does not disclose receiving non-negotiable and negotiable values, receiving from said matching computer a notification of a potential match between said values, a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a fourth region for displaying a negotiation between said input, a fifth display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

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patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

7. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley (US 4,677,552).

Sibley discloses a negotiated matching system and a method for displaying a user interface on at least one terminal in a negotiated matching system (trade exchange which transmits data representing bids and offers col. 1, lines 5-15) comprising six display regions (Fig. 9).

Sibley does not disclose receiving non-negotiable and negotiable values, receiving from said matching computer a notification of a potential match between said values, a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a fifth display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does

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not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

8. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (US 4,903,201 or 4,980,826).

Wagner discloses a negotiated matching system and a method for displaying a user interface on at least one terminal in a negotiated matching system comprising six display regions (futures trading exchange which compares any bid with offers, finds a match and completes transaction, col. 1, lines 5-14, user interface for trading system (Fig. 19).

Wagner does not disclose a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a fifth display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

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However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

9. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiseman (5,168,446).

Wiseman discloses a negotiated matching system and a method for displaying a user interface on at least one terminal in a negotiated matching system comprising six display regions (system for processing transactions between commodity traders col. 2, lines 10-24, Fig. 7a-20B).

Wiseman does not disclose receiving non-negotiable and negotiable values, receiving from said matching computer a notification of a potential match between said values, a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a fifth



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display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

***In the alternative:***

10. Claims 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley, Jr (4,677,552) or Shavit et al (4,799,156) or Wagner (4,903,210 or 4,980,826) or Silverman et al (5,077,665 or 5,136,501) or Wiseman (5,168,446) in view of Kosaka et al (5,267,148) or Gutterman et al (5,297,031) or Trojan et al. (5,297,032).

Sibley or Shavit or Wagner or Silverman or Wiseman disclose a method and system requiring a user to input data about offers to either buy or sell items. They do not disclose six display regions.

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However, Kosaka (Fig. 10, col. 5, lines 45-61 (information Multi-window output), Gutterman (Figs. 2a-2d), and Trojan (Fig. 2, col. 5, lines 43-58) disclose displaying the information in regions.

It would have been obvious to one of ordinary skill in the art to incorporate into the discloses of Sibley, Shavit, Wagner, Silverman, or Wiseman the teachings of Kosaka, Gutterman or Trojan to provide a display means that allows the trader to track the market, select securities, bid and ask pricing, market direction and market depth so as to provide more complete and copious knowledge about the market.

Neither Sibley, Shavit, Wagner, Silberman, Wiseman, Kosaki, Gutterman, or Trojan disclose receiving non-negotiable and negotiable values, receiving from said matching computer a notification of a potential match between said values, a first display region for displaying input of non-negotiable values, a second display region for displaying negotiable values, a third display region for displaying a potential match, a forth region for displaying a negotiation between said input, a fifth display region displaying a group of counter parties, a sixth display region displaying an input of ranking criteria or a specific market, or local limits, or global limits, or selection of a market or a market's best bid and offer.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps or structure recited. The data does not alter how the system functions or the steps are performed. The matching and displaying would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of

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patentability, see *In re Gulack*, 703 F. 2d. 1381, 1385, 217 USPQ 401, 404 (Fed Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to display any type on the regions of the interface because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

### ***Double Patenting***

11. Although applicant states that a terminal disclaimer is submitted herewith, page 8, paragraph 3 of the Remarks/Arguments section, the Examiner is unable to locate the disclaimer.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-39 of U.S. Patent No. 5,924,082. Although the conflicting claims are not identical, they are not patentably distinct from each other because it appears that some display would be inherent or at least

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obvious in order to conduct a transaction including, negotiations, leaving the question of obviousness of a display portion for potential matches.

***Response to Arguments***

12. Applicant's arguments filed October 12, 2004 have been fully considered but they are not persuasive.

The applicant states on page 9 of the response that the present invention pertains to a user terminal of a negotiating matching system, which identifies potential parties to a potential transaction based on one or more fixed trading parameters. The applicant further states that the system introduces compatible counter parties who are provided with an opportunity to communicate with one another prior to execution of the transaction to negotiate some or all terms of the transaction.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features as set forth above are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicant argues that claims 12 and 29 recite a system and method wherein the subject matter and the subject matter of the displays of negotiable and non-negotiable information are functionally related to the user terminal and are not taught or suggested by the prior art. However, the Examiner has determined this data to be non-functional descriptive data. Claims 12 and 29 are directed to providing or presenting information via a user interface. The display of the information via a user interface is related to

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precedents dealing with printed matter – ie, the presentation of information in a form that is useful and intelligible only to the human mind. See *In re Gulack*, 703 F 2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) (Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability.”) When certain types of descriptive material, such as mere arrangements or compilations of facts or data, are merely stored so as to be or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality to the data, or the computer. The question, as set forth in *In re Lowry*, is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.

In response to applicant's argument that none of the prior art references have a need one or more data elements to fulfill their purposes, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's arguments, much of the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the

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preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The applicant states that the Examiner failed to provide a basis for applying Gutterman as a reference. However, the Examiner has referred to the language in the rejection which states that Kosaka, Gutterman, and Trojan teach displaying the information in regions.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

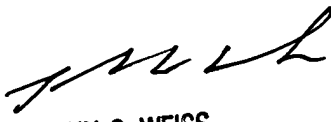
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm

  
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